Rejections under 35 USC § 102(b)

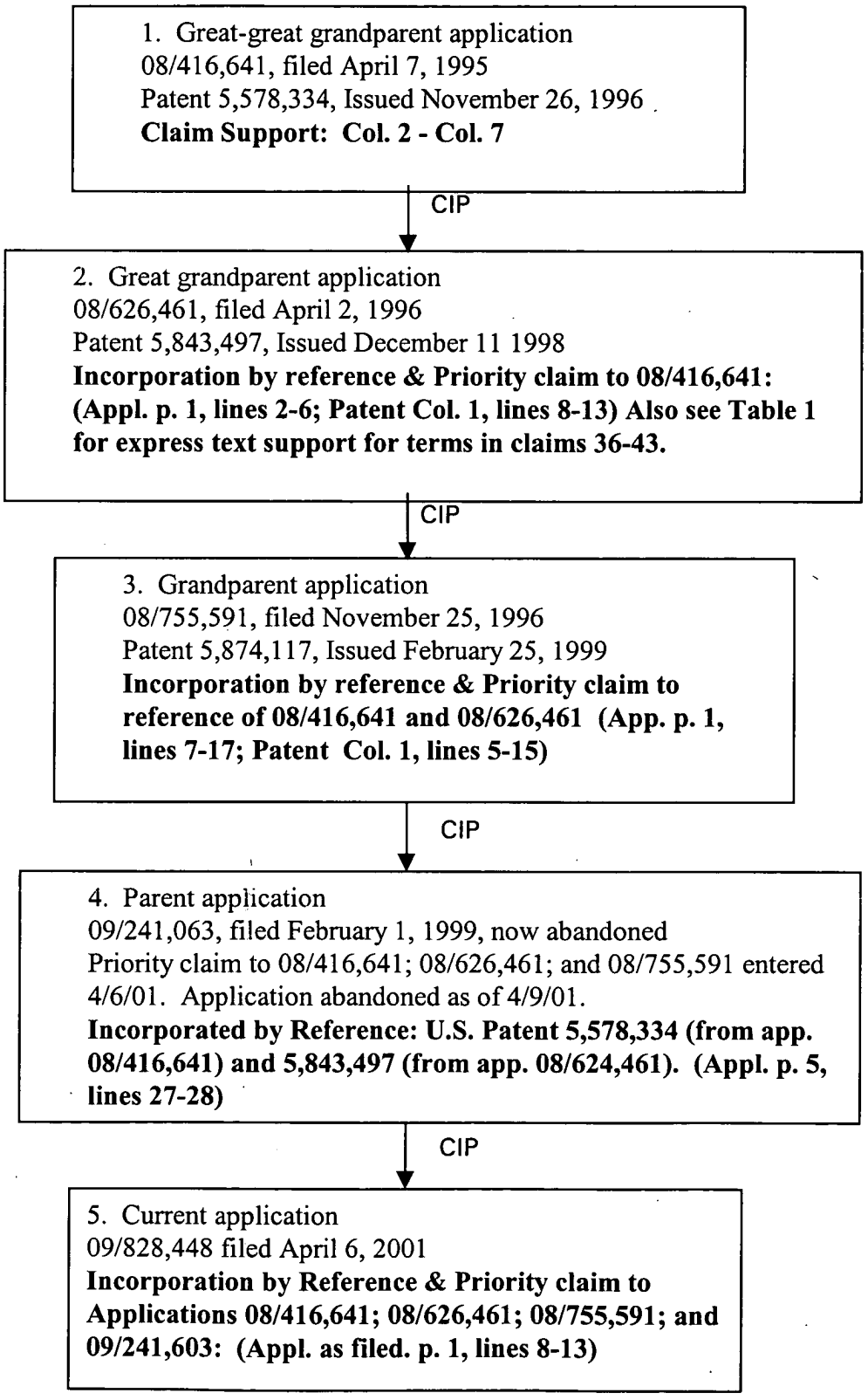
The Examiner rejected all the pending claims under 35 USC § 102(b) as allegedly being anticipated by Sundram et al., U.S. Patent 5,843,497. The Examiner acknowledged that the present application claims priority to a series of preceding applications, but asserted that the parent application 09/241,603 was directed to a different invention than is presently claimed. Applicant respectfully traverses this rejection.

As shown by the evidence discussed in the following remarks, the '497 patent cited by the Examiner cannot be prior art under 35 USC § 102(b) to the pending claims, because the description contained in that patent is included through incorporation by reference in each of the applications leading to the present case. The incorporation by reference of the earlier descriptions in each of the applications up to and including the present case is summarized in section A, in a flow diagram which includes citations to text in the applications (or corresponding issued patent). In addition, in section B of the discussion, a brief consideration of case law and MPEP guidelines is provided to confirm, should there remain any doubt, that the description by incorporation by reference in combination with the priority claims entitles Applicant to the benefit of the earlier filing dates. Section C demonstrates that the '497 patent cited by the Examiner contains specific support for the pending claims, and Section D expands on the summary provided in the flow diagram in Section A by quoting the text in the earlier applications where the description supporting the current claims is incorporated by reference. Additional citations to text where the present invention is described in some of the applications is also provided in Section D.

A. Summary Diagram Showing Incorporation by Reference and Priority Claims

For reference, the relationships of the unbroken chain of applications leading to the present application are shown in the following summary diagram.

Diagram Showing Relationships of Related Applications and Description of Present Claimed Invention by Incorporation by Reference



The Examiner's assertion that the parent application concerns a different invention than the present case, and the rejection of the claims for alleged anticipation over the Patent 5,843,497, necessarily implies that the Examiner is asserting that the claims of the present application are not entitled to the benefit of the filing dates of the earlier-filed applications in the priority chain because the parent application allegedly does not describe the invention now claimed.

To the contrary, U.S. Patent 5,843,497 (issued from Appl. No. 08/626,461) cannot be anticipating prior art to the present claims. The diagram above shows that the entire description of the '497 patent has been included in each of the intervening applications in the unbroken priority chain leading to the present application, through incorporation by reference. Because the entire description of the '497 patent has been included in the each of those applications, the present claims are entitled to the benefit of the filing dates of each of the applications in the priority chain, such that the '497 patent cannot be anticipating prior art to the present claims.

B. Standard for Entitlement to Benefit of Filing Date of Earlier-Filed Application

In case the Examiner retains any doubt following review of the summary in section A above, the conclusion that the present claims are entitled to the benefit of the filing dates of the earlier-filed applications in the priority chain is consistently supported by controlling case law, and is confirmed in MPEP guidelines. Thus, the Federal Circuit has held that in order to be entitled to priority to an earlier-filed application for a claimed invention, the earlier-filed U.S. patent application must "contain a disclosure which complies with 35 U.S.C. § 112, ¶ 1." Thus, "a claim complies with 35 U.S. C. § 120 and acquires an earlier filing date if, and only if, it could have been added to an earlier application without adding new matter." (*Studiengesellschaft Kohle M.B.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564; 42 U.S.P.Q. 2d 1674, 1677 (Fed. Cir. 1997) *cert. denied*, 118 S. Ct. 560 (1997); see also *Lampi Corp. v. American Power Products, Inc.*, 228 F.3d 1365, 1377, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000).)

However, Section 120 "does not place any limitation on how the now claimed invention must be disclosed in the earlier application." (*Ex parte Maziere*, 27 U.S.P.Q. 2d 1705, 1706 (Bd. Pat.App. and Int'f. 1993).) As one method of providing the required description, it is well-settled that an application may describe even essential subject matter by incorporating by reference an issued U.S. Patent. (See, MPEP 608.01(p)(I)(A).) Further, Applicant's ability to claim priority to an earlier application that incorporates material by reference is also clearly stated in the MPEP. In particular, the first paragraph of MPEP 608.01(p)(I)(B) states that "an application is entitled to rely upon the filing date of an earlier application, even if the earlier application itself incorporates essential material by reference to another document." (citing *Ex parte Maziere*, 27 USPQ2d 1705, 1706-1707 (Bd. Pat. App. & Inter. 1993).)

In accordance with this case law, the above summary shows that the parent application 09/241,603, as well as each of the additional applications in the claimed series of priority applications, includes description of the invention claimed in the present application, because each of the applications following the first-filed application (the great-great grandparent application) incorporated earlier disclosures by reference. This specifically includes incorporation by reference of the description from the application that issued as U.S. Patent 5,843,497. Because each of the applications in the chain incorporated prior disclosures by reference and claimed priority to each of the earlier-filed applications in the priority chain, the current claims are entitled to the filing dates of each of the applications in the priority chain. Therefore, as stated above, the '497 patent cannot be anticipating prior art to the present claims.

C. Support in U.S. Patent 5,843,497 for the Present Claims

As shown above, both the parent application and the present application include the description provided in U.S. Patent 5,843,497 through incorporation by reference. In addition, Table 1 below shows that the description in the '497 patent specifically supports the currently pending claims. Pending claims 36-43 are specifically considered; essentially the same description supports the other claims. Citations to exemplary specific text are

included in Table 1 (citations are to the application, to the issued patent when applicable, or to both).

For the Examiner's convenient reference, Claim 36 is provided below, and all the pending claims are attached as Appendix 1.

36. A cholesterol-free margarine, comprising

a blend of polyunsaturated fat and saturated fat, forming a cholesterol-free blended fat composition,

wherein said blended fat composition comprises

between 15% by weight and 40% by weight linoleic acid,

between 20% and 40% by weight saturated fatty acids comprising at least one saturated fatty acid selected from the group consisting of lauric acid, myristic acid, and palmitic acid, and

no more than 1% elaidic acid or other unnatural trans fatty acids by weight;

wherein the ratio of polyunsaturated fatty acids to saturated fatty acids is from 0.5:1 to 2:1, and wherein said cholesterol-free fat composition is suitable for ingestion by a human as a food product and for increasing the HDL concentration and the HDL/LDL concentration ratio in the blood serum following ingestion by a human.

Table 1: Support in '497 Patent for pending claims of Application No. 09/828,448

Claim No.	Claim term	Examples of Support in Patent 5,843,497
36	Margarine	col. 7, l. 61
	Cholesterol-free	col. 7, l. 52
	Blended fat composition	col. 6, l. 33; col. 5, l. 17
	Between 15% by weight and 40% by weight linoleic acid	col. 5, l.22
	Between 20 and 40% by weight saturated fatty acids	col. 5, l.. 23-24
	no more than 1% elaidic acid or other unnatural fatty acids by weight	col. 4, ll. 42-44
	Ratio of polyunsaturated fatty acids to saturated fatty acids is from 0.5 to 1 to 2:1	col. 6, ll. 33-35
	Suitable for ingestion by a human as a food product	col. 6, ll. 36-37 col. 3, l. 45
	Increasing the HDL concentration and the HDL/LDL concentration ratio in the blood serum	col. 3, ll. 37-39
37	Ratio of polyunsaturated fatty acids to saturated fatty acids is 1:1 ± 20%	col. 6, ll. 34-35
38	Between 20% and 50% by weight oleic acid	col. 4, ll. 41-42
39	Approximately 30% by weight palmitic acid and approximately 30% by weight linoleic acid plus linolenic acid	col. 3, ll. 55-56
40	Comprises at least one polyunsaturated vegetable oil selected from the group consisting of corn oil, sunflower oil, safflower oil, soybean oil, cottonseed oil, canola oil, and peanut oil; and said saturated fat comprises at least one saturated vegetable oil selected from the group consistin gof palm fat, coconut fat and cocoa butter	col. 5, ll. 32-39 col. 6, ll. 56-63
41	Palm fat is selected from the group consisting of palm oil, palm olein, and palm kernel oil	col. 5, ll, 35-36 col. 6, ll. 58-60
42	Polyunsaturated fat consists essentially of soybean oil, and said saturated fat consists essentially of palm fat	col. 13, ll. 63-67
43	at least one polyunsaturated fat selected from the group consisting of alpha-linolenic acid, eicosapentenoic acid (EPA), and docosahexenoic acid (DHA)	col. 4, ll. 45-47 col 13, ll.8-12

As shown in the above table, the description provided in the application that issued as the '497 patent and incorporated by reference in subsequent applications supports the present claims.

D. Additional Detailed Discussion of Entitlement to Filing Date of Applications in Priority Chain

The diagram and discussion in Sections A and B above, demonstrate that the present claims are entitled to the benefit of the filing dates of each of the applications in the priority chain. However, in order to still further demonstrate that the present application is entitled to the benefit of those filing dates, the quotations from the respective applications that show the incorporation by reference of prior descriptions (summarized in the above diagram) are provided in this section and briefly discussed. In addition, further exemplary text support for the present claims in some of the applications is also pointed out. The applications are addressed individually in the order in which they were filed.

Turning to the first-filed application in the chain of related applications leading to the present case:

1. Application 08/418,641, filed April 7, 1995, issued Nov. 26, 1996 as U.S. Patent 5,578,334 (Great-great-grandparent application)

Considering claim 36 of the present application (see claim above), in Patent 5,578,334, reference to margarine is provided at col. 7, lines 34-35; support for the term "cholesterol-free blended fat composition" is provided at col. 5, lines 16-17 and col. 6, line 33; the balanced ratio of fatty acids and the ranges of linoleic acid and saturated fatty acids is described, for example, at col. 2, line 58 to col. 3, line 28; substantial absence of elaidic acid is described at col. 3, lines 58-62; the 0.5:1 to 2:1 range for the ratio of polyunsaturated fatty acids to saturated fatty acids is described at col. 6, lines 33-34; suitability for ingestion by humans is described throughout by reference to use of the blended fat composition in preparation of human food, such as at col. 7, lines 52-65; and

the effects on HDL level and HDL/LDL ration in blood serum is described at col. 3, lines 3-5. Thus, application 08/418,641 describes the invention as claimed in the present application.

2. Application 08/626,461, filed April 2, 1996, issued Dec. 1, 1998 as U.S. Patent 5,843,497 (Great-grandparent application cited by the Examiner)

As noted above, the Examiner cited the '497 patent as allegedly being anticipating prior art under 36 U.S.C. 102(b). The application as filed stated that "This application is a continuation-in-part of Sundram et al., U.S. Serial No. 08/418,641, filed April 7, 1995, entitled "INCREASING THE HDL LEVEL AND THE HDL/LDL RATIO IN HUMAN SERUM WITH FAT BLENDS, hereby incorporated by reference". By this statement, the '461 application claimed priority to the above application and incorporated the disclosure of that application by reference. (Col. 1, lines 8-13; see, p.1, lines 2-6 in the application as filed.)

In addition, specific support for present claims 36-43 is shown in Table 1 above.

In view of the description incorporated by reference from the preceding application and the further express description provided in the text of the specification, application 08/626,461 clearly provides description of the present claimed invention.

3. Application 08/755,591, filed November 25, 1996, issued February 23, 1999 as U.S. Patent 5,874,117 (Grandparent application)

In the first paragraph of the grandparent application as filed (U.S. Patent 5,874,117, col. 1, lines 5-15), the application claimed priority to the preceding applications, and incorporated them by reference, reading:

> This application is a continuation-in-part of Sundram et al., U.S. Ser. No. 08/626,461, filed Apr. 2, 1996, entitled "Increasing the HDL Level and the HDL/LDL Ratio in Human Serum by Balancing Saturated and Polyunsaturated Dietary Fatty Acids" which is a continuation-in-part of Sundram et al., U.S. Ser. No. 08/418,641, filed Apr. 7, 1995 entitled

"Increasing he HDL Level and the HDL/LDL Ratio in Human Serum with Fat Blends" which will issue as U.S. Pat. No. 5,578,334, hereby incorporated by reference herein in their entirety.

In addition, the text of this application (and issued patent) include description of the blended fat compositions and their use for increasing HDL and the HDL/LDL ratio as described in the preceding applications. (Col. 4, line 39 to col. 6, line 23; col. 8, line 56 to col. 13, line 20.) Included is an additional indication of the incorporation by reference of Application No. 08/626,461. (Col. 8, lines 58-62.)

In view of the incorporation by reference of the preceding applications in their entireties, and the inclusion of text expressly describing the blended fat compositions and their dietary use, this application also clearly contains description of the invention now claimed.

4. Application No. 09/241,603, filed February 1, 1999, now abandoned (Parent application)

Application 09/241,603 was filed with claims directed to a filled dairy product and related claims. On April 6, 2001 the application was amended to include reference to each of the above related applications, a substitute Declaration was filed claiming priority to each of those applications, and a request for an extension of time was filed, such that application 09/241,603 was co-pending with the present application. The amendment to refer to the prior related applications also stated that those applications were incorporated by reference in their entireties. However, this statement of incorporation by reference is not relied on here to demonstrate that the present claims are entitled to the benefit of the earlier-filed applications.

As discussed above, the Examiner asserted that Application No. 09/241,603, was directed to a different invention than is presently claimed. As a result, the Examiner alleged that U.S. Patent 5,843,497 is anticipating prior art to the present claims. In view of Applicant's claim of priority to the above earlier-filed applications, such an assertion

necessarily means that the Examiner is asserting that the '603 application does not sufficiently describe the invention as specified in the current pending claims.

Contrary to the Examiner's assertion, Applicant respectfully submits that parent application 09/241,603 includes the presently claimed invention and properly describes this invention, in accordance with *Studiengesellschaft Kohle* and *Lampi* discussed above. Those cases demonstrate that the question is whether the '603 application "describes" the present invention, not whether it contains or ever contained claims to that invention. As also pointed out above, the manner of that description is not limited, and specifically can be satisfied through incorporation by reference.

Indeed, as shown in the summary diagram in Section A above, application 09/241,603, the parent to the present application, specifically incorporated U.S. Patents 5,843,497 and 5,578,334 by reference in their entireties. Specifically, at p. 5, lines 27-28, the '603 application as filed read, "It was also found that a filled milk product (or other filled dairy product) containing a substantial proportion of polyunsaturated vegetable oil could be produced, in which the balance between saturated fats and polyunsaturated fats is consistent with the ranges recommended in Sundram et al., U.S. Patent 5,578,334 and Sundram et al, U.S. Patent 5,843,497, which are hereby incorporated by reference in their entireties, including drawings." As pointed out above, these two patents issued from applications in the present chain of priority applications. Thus, the entire disclosures of these patents is included in the '603 application through incorporation by reference, providing full and specific support for the present claims.

In addition to the specific incorporation by reference of the '334 and '497 patents, the '603 application as filed again incorporated those patents by reference in the statement at p. 31, lines 14-15, which read, "All references cited in this disclosure are incorporated by reference to the same extent as if each reference had been incorporated by reference in its entirety individually."

Therefore, as a result of the incorporation by reference of issued patent 5,843,497 (as well as issued patent 5,578,334) in parent application 09/241,603, that parent

application properly described the invention now claimed. As a direct consequence of the fact that the content of the '497 patent was properly incorporated by reference in the parent application, the present claims could properly have been presented in that application without introducing new matter, thereby satisfying the standard for claiming priority as stated in *Studiengesellschaft Kohle* and *Lampi* (*supra*).

As a result, because parent application 09/241,603 properly describes the present claimed invention and therefore satisfies the requirement for claiming priority to the earlier-filed applications, Applicant is entitled to the filing date of the parent application. Further, as shown above, each of the additional applications listed in the chain of priority applications also describes the present invention through incorporation by reference and, in some cases, also through additional express text in the specification. (As pointed out above, Applicant's entitlement to the earlier filing dates based on incorporation by reference is directly shown by MPEP 608.01(p)(I)(B).) In particular, the present application is properly entitled to claim priority to Application 08/626,461, which issued as U.S. Patent 5,843,497, such that Patent 5,843,497 cannot be prior art to the present invention under 35 U.S.C. 102(b) as asserted by the Examiner. Since Patent 5,843,497 cannot be prior art to the present claims, it cannot anticipate those claims as alleged by the Examiner.

Conclusion

To summarize the above remarks, the present application properly claimed priority to the specified chain of prior related applications. Each of those prior related applications, including parent application 09/241,603, properly described the present claimed invention, such that the present claims are entitled to the benefit of the filing dates of each of those earlier-filed applications. As a result, neither U.S. Patent 5,843,497, nor either of the other two patents that issued from the respective prior related applications can be prior art to the present claims, and so cannot anticipate those claims. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejections.

Applicant submits that the present application is now in condition for allowance, and respectfully requests a notice to that effect.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 12/27/02

By _____

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Claims for GFA 050811-0207

28. (New) A cholesterol-free margarine, comprising

a blend of one part by weight polyunsaturated fat and at least one part by weight saturated fat, forming a cholesterol-free blended fat composition,

wherein said blended fat composition comprises

between 15% by weight and 40% by weight linoleic acid,

between 20% and 40% by weight saturated fatty acids comprising at least one saturated fatty acid selected from the group consisting of lauric acid, myristic acid, and palmitic acid, and

no more than 1% elaidic acid or other unnatural trans fatty acids by weight;

wherein the ratio of polyunsaturated fatty acids to saturated fatty acids is from 0.5:1 to 2:1, and wherein said cholesterol-free fat composition is suitable for ingestion by a human as a food product and for increasing the HDL concentration and the HDL/LDL concentration ratio in the blood serum following ingestion by a human.

29. (New) The margarine of claim 28, wherein said ratio of polyunsaturated fatty acids to saturated fatty acids is 1:1 ± 20%.

30. (New) The margarine of claim 28, wherein said blended fat composition further comprises between 20% and 50% by weight oleic acid

31. (New) The margarine of claim 28, comprising approximately 30% by weight palmitic acid and approximately 30% by weight linoleic acid plus linolenic acid.

32. (New) The margarine of claim 28, wherein said polyunsaturated fat comprises at least one polyunsaturated vegetable oil selected from the group consisting of corn oil, sunflower oil, safflower oil, soybean oil, cottonseed oil, canola oil, and peanut oil; and

said saturated fat comprises at least one saturated vegetable oil selected from the group consisting of palm fat, coconut fat, and cocoa butter.

33. (New) The margarine of claim 32, wherein said palm fat is selected from the group consisting of palm oil, palm olein, and palm kernel oil.

34. (New) The margarine of claim 28, wherein said polyunsaturated fat consists essentially of soybean oil, and said saturated fat consists essentially of palm fat.

35. (New) The margarine of claim 28, wherein said fat composition further comprises at least one polyunsaturated fatty acid selected from the group consisting of alpha-linolenic acid, eicosapentenoic acid (EPA), and docosahexenoic acid (DHA).

36. (New) A cholesterol-free margarine, comprising

a blend of polyunsaturated fat and saturated fat, forming a cholesterol-free blended fat composition,

wherein said blended fat composition comprises

between 15% by weight and 40% by weight linoleic acid,

between 20% and 40% by weight saturated fatty acids comprising at least one saturated fatty acid selected from the group consisting of lauric acid, myristic acid, and palmitic acid, and

no more than 1% elaidic acid or other unnatural trans fatty acids by weight;

wherein the ratio of polyunsaturated fatty acids to saturated fatty acids is from 0.5:1 to 2:1, and wherein said cholesterol-free fat composition is suitable for ingestion by a human as a food product and for increasing the HDL concentration and the HDL/LDL concentration ratio in the blood serum following ingestion by a human.

37. (New) The margarine of claim 36, wherein said ratio of polyunsaturated fatty acids to saturated fatty acids is 1:1 ± 20%.

38. (New) The margarine of claim 36, wherein said blended fat composition further comprises between 20% and 50% by weight oleic acid

39. (New) The margarine of claim 36, comprising approximately 30% by weight palmitic acid and approximately 30% by weight linoleic acid plus linolenic acid.

40. (New) The margarine of claim 36, wherein said polyunsaturated fat comprises at least one polyunsaturated vegetable oil selected from the group consisting of corn oil, sunflower oil, safflower oil, soybean oil, cottonseed oil, canola oil, and peanut oil; and

said saturated fat comprises at least one saturated vegetable oil selected from the group consisting of palm fat, coconut fat and cocoa butter.

41. (New) The margarine of claim 37, wherein said palm fat is selected from the group consisting of palm oil, palm olein, and palm kernel oil.

42. (New) The margarine of claim 36, wherein said polyunsaturated fat consists essentially of soybean oil, and said saturated fat consists essentially of palm fat.

43. (New) The margarine of claim 36, wherein said fat composition further comprises at least one polyunsaturated fatty acid selected from the group consisting of alpha-linolenic acid, eicosapentenoic acid (EPA), and docosahexenoic acid (DHA).

44. (New) A cholesterol-free margarine, comprising

a blend of soybean oil and palm oil, forming a cholesterol-free blended fat composition,

wherein said cholesterol-free blended fat composition comprises

between 15% by weight and 40% by weight linoleic acid,

between 20% and 40% by weight saturated fatty acids comprising at least one saturated fatty acid selected from the group consisting of lauric acid, myristic acid, and palmitic acid, and

no more than 1% elaidic acid or other unnatural trans fatty acids by weight;

wherein the ratio of polyunsaturated fatty acids to saturated fatty acids is from 0.5:1 to 2:1, and wherein said cholesterol-free blended fat composition is suitable for ingestion

by a human as a food product and for increasing the HDL concentration and the HDL/LDL concentration ratio in the blood serum following ingestion by a human.

45. (New) The margarine of claim 44, wherein said blend consists of one part by weight soybean oil and at least one part by weight palm fat.

46. (New) The margarine of claim 44, wherein said ratio of polyunsaturated fatty acids to saturated fatty acids is 1:1 ± 20%.

47. (New) The margarine of claim 44, wherein said blended fat composition further comprises between 20% and 50% by weight oleic acid

48. (New) The margarine of claim 44, comprising approximately 30% by weight palmitic acid and approximately 30% by weight linoleic acid plus linolenic acid.

49. (New) The margarine of claim 45, wherein said palm fat is selected from the group consisting of palm oil, palm olein, and palm kernel oil.